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OFFICE OF PETITIONS

In re Application of
Arini, et al.
Application No.: 10/817,213
Filed: April 2, 2004
Attorney Docket No.: PA0385
For: METHOD OF, AND COMPUTER
SOFTWARE FOR, CLASSIFICATION OF
CELLS INTO SUBPOPULATIONS

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed October 29, 2004 (certificate of mailing date October 27, 2004).

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on April 2, 2004 without an executed oath or declaration. Accordingly, on May 24, 2004, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on October 29, 2004 (certificate of mailing date October 27, 2004), a petition for a four month extension of time and required fee, a declaration executed by 8 of 9 joint inventors, the surcharge, the petition fee, and the instant petition were filed. A statement from Bailiff Jim Marlow of the City of Niagara Falls in the Regional Municipality of Niagara, Ontario, Canada accompanies the petition. Mr. Marlow explains that when he attempted to deliver a package at the last known address of the non-signing inventor, Jurek Cybuch, that the current owner told him that Mr. Cybuch had died and that the previous owner, Ms. Kateryna Turczyn, had sold the house and moved to Europe.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s)/legal representative refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s)/legal representative.

This petition lacks item (1), (2), and (4) above.

As to item (1), Rule 47 has no application to a deceased inventor. MPEP 409.03(c) However, Rule 47 does apply where a legal representative of a deceased inventor cannot be found or reached after diligent effort, or has refused to make application. Applicant has failed to establish that the legal representative of the deceased inventor cannot be located or has refused to sign the declaration. It appears that petitioners have made no effort to locate a legal representative for the deceased inventor.

The Office requires that the legal representative of the deceased inventor be provided with a complete copy of the application as filed. This includes the specification with claims, drawings, if any, and a declaration. See MPEP 409.03(d).

The legal representative must have the complete application in his/her possession in order to make an informed decision as to whether he/she joins in its filing. The legal representative cannot make the necessary statements -- "I have reviewed and understand.." etc.-- without looking at the application papers.

Once delivery of the complete application to the legal representative's last known address is established and no response has been received within a reasonable amount of time, applicant will have shown constructive refusal by the legal representative to join in the filing of the application.

If petitioners allege that the legal representative of the deceased inventor cannot be reached, petitioners must engage in diligent efforts to locate him/her. Where inability to find or reach a nonsigning inventor is alleged, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied upon to establish that a diligent effort was made to locate the nonsigning inventor.

The affidavit or declaration of facts must be signed, where at all possible, by a person having *firsthand knowledge* of the facts recited therein. Statements based on hearsay will not normally be accepted

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The declaration contains no information for the legal representative. **Petitioners must submit another declaration that lists identifying information for the inventors, including the deceased inventor, and the legal representative. This new declaration must be executed by the signing inventors.** The identifying information must include: -- Name, Residence, Citizenship, and Post Office. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicant on behalf of the deceased inventor's legal representative is REQUIRED. See MPEP 409.03(a).

As to (4) above, the last known address of the legal representative must be given. See MPEP 409.03(c).

Pursuant to petitioners' authorization, deposit account no. 50-2590 will be charged the \$130.00 petition fee owed. The Office has already charged the \$130.00 surcharge and the \$1,530.00 four month extension of time fee to the same deposit account.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
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Post Office Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza 2, Lobby, Room 1B03
Arlington, VA 22202

By FAX: (703) 872-9306 – ATTN: Office of Petitions

Telephone inquiries should be directed to the undersigned at (571) 272-3230.



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